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10/686,444	10/15/2003	Leonid Matsiev	1012.122C5	6855

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EXAMINER

MILLER, ROSE MARY

ART UNIT PAPER NUMBER

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DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/686,444	Applicant(s) MATSIEV ET AL.	
	Examiner Rose M. Miller	Art Unit 2856	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7, 10-18, 20-23, 26-30 and 32-40 is/are rejected.
- 7) ☒ Claim(s) 5, 6, 19, 24, 25 and 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, a measurement circuit adapted for operation of the plurality of mechanical resonators in free decay mode and a pulse generator for generating a voltage spike input signal to cause the resonators to oscillate (as recited in claims 32 and 37 respectfully) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The specification filed 15 October 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure (as filed in Parent Application 10/266,047) is as follows: Figures 1-2, 7, 8, 10 and 11, all subject matter in the

specification pertaining to the Figures, and all subject matter which was not disclosed in Parent Application 10/266,047.

Applicant is required to cancel the new matter in the reply to this Office Action.

3. The above objection arises from Applicant's attempt to re-introduce subject matter disclosed in Original filed Application 08/946,921 but which was dropped from prosecution with the filing of CIP Application 09/133,171. It is clear from the multiple applications claiming Priority to Application 09/133,171 that the subject matter not included in 09/133,171 was not "inadvertently" dropped. Such "inadvertent" dropping would have allowed for the re-insertion of such subject matter. However, as it is clear this subject matter was deliberately dropped instead of "inadvertently" dropped, the subject matter cannot be added at this time if the present Application is to maintain its status as a Continuation of 10/266,047.

The MPEP § 201.07 is clear on the definition of a Continuation Application. The Disclosure **must** be the same as that of the original application and should **not** include anything that would constitute new matter if inserted in the original application.

201.07 [R-2] Continuation Application

A continuation is a second application for the same invention claimed in a prior nonprovisional application and filed before the original prior application becomes abandoned or patented. The continuation application may be filed under 37 CFR 1.53(b) >(or 1.53(d) >if the application is a design application)<. The applicant in the continuation application must include at least one inventor named in the prior nonprovisional application. The disclosure presented in the continuation must be the same as that of the original application; i.e., the continuation should not include anything which would constitute new matter if inserted in the original application. The continuation application must claim the benefit of the prior nonprovisional application under 35 U.S.C. 120 or 365(c).

The MPEP provides clear guidelines on the filing of a Continuation or Divisional Application with the following:

SPECIFICATION AND DRAWINGS

A continuation or divisional application may be filed under 35 U.S.C. 111(a) using the procedures set forth in 37 CFR 1.53(b), by providing: (A) a copy of the prior application, including a copy of the signed oath or declaration in such prior application, as filed; (B) a new specification and drawings and a copy of the signed oath or declaration as filed in the prior application provided the new specification and drawings do not contain any subject matter that would have been new matter in the prior application; or (C) a new specification and drawings and a newly executed oath or declaration provided the new specification and drawings do not contain any subject matter that would have been new matter in the prior application. If a continuation or divisional application filed with a newly executed oath or declaration contains subject matter that would have been new matter in the prior application, the application will have to be amended to indicate that it is a continuation-in-part application rather than a continuation or a divisional application. The specification and drawings of a continuation or divisional application filed under 37 CFR 1.53(b) are not limited to a reproduction or "true copy" of the prior application, i.e., the applicant may revise the specification for clarity or contextual purposes vis-à-vis the specification originally filed in the prior application in the manner that an applicant may file a substitute specification, see 37 CFR 1.125, or amend the drawings of an application so long as it does not result in the introduction of new matter. It is the applicant's responsibility to review any new specification or drawings submitted for a continuation or divisional application under 37 CFR 1.53(b) and 37 CFR 1.63(d) to determine that it contains no new matter. An applicant is advised to simply file a continuing application with a newly executed oath or declaration when it is questionable as to whether the continuing application adds material that would have been new matter if presented in the prior application. If one or more claims are allowed in the continuation or divisional application which are directed to matter shown and described in the prior nonprovisional application but not claimed in

the prior application, the applicant should be required to file a supplemental oath or declaration under 37 CFR 1.67(b).

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

This includes the referencing of other Application within the Specification. All references to Applications before the office should be updated to reflect the current status of the Application cited.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 20-23 and 32-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the originally filed specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed specification (as found in parent applications 10/266047, 10/201181, and 10/133171) fails to provide support for the resonators being excited by a "voltage spike" (as found in claims 22 and 37). Original Parent Application 08/946921 does refer to the use of a "spike voltage" as the means for exciting the resonator. However, this is material which Applicant dropped with the filing of CIP Parent 09/133171 and therefore it cannot be recouped at this time as the material was not inadvertently dropped as required in order to bring such matter back into the Application.

The originally filed specifications (as filed in Parent Applications 10/266047, 10/201181, and 10/133171) also do not provide support for the resonators to be

operated in a free decay mode as found in claims 20 and 32. As with the material above, the "free decay" operation of the resonator can be found in originally filed Parent Application 08/946921. However, this was part of the subject matter dropped by Applicant when Applicant filed CIP Parent 09/133171. As this was not an "inadvertent" dropping of subject matter (as clearly indicated by the multiple applications filed from the CIP Parent 09/133171), Applicant cannot recoup such subject matter at this time if the present Application is to maintain its status as a Continuation of 10/266047.

Claims 21, 23, 33-36 and 38-40 are rejected as they depend from rejected claims 20, 22, 32 and 37 and therefore contain the subject matter of such claims.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 27 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by **Hollis et al. (US 5,653,939)**.

Hollis et al. discloses a sensor for characterizing a fluid, the sensor comprising a plurality of mechanical resonators (see column 7 line 63 – column 8 line 58), each of the plurality of resonators having an operational frequency of less than 1 MHz (see lines 9-12 of column 8), the plurality of resonators being adapted for measuring physical or chemical properties of the fluid (see column 8 lines 13-18), a sweep generator for generating a variable frequency input signal to cause the resonators to oscillate (see column 8 lines 38-41, sweep 708), and a measurement circuit coupled with the

resonators (see column 7 line 63 – column 8 line 58), the measurement circuit comprising the sweep generator (708) and a receiver (meter 710) coupled to the measurement circuit to output a frequency response of the resonators.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1-4, 7, 10-18, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Newell et al. (US 4,760,351)** in view of **Tanaka et al. (US 3,710,275)** and **Vali et al. (US 5,179,028)**.

Newell et al. discloses a sensor for characterizing a fluid composition comprising a plurality of mechanical resonators (100, 102, 104, 106) in combination, the plurality of resonators being adapted for measuring physical (humidity, pressure, etc.) or chemical properties (see Figure 10) of the fluid composition.

With regards to claim 1, **Newell et al.** discloses the claimed invention with the exception of the plurality of resonators comprising a low frequency tuning fork resonator and a high frequency tuning fork resonator and at least one of the resonators having an

operational frequency of less than 1 MHz. **Tanaka et al.** teaches that it is known in the oscillator art to provide an array of tuning fork resonators in place of the usual crystal oscillators. **Tanaka et al.** also teaches altering the tines of the array in order to produce tuning forks with different resonant frequencies. **Vali et al.** teaches that it is known to utilize tuning forks as chemical sensors in order to determine the presence of specific chemicals in a fluid composition. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the tuning fork oscillators of **Tanaka et al.** for the crystal oscillators of **Newell et al.** as **Vali et al.** teaches the versatility of the tuning fork resonator in being able to determine multiple chemicals with a single sensor and such a substitution would allow for more chemicals to be tested for. As for the use of a low frequency tuning fork resonator and a high frequency tuning fork resonator, **Newell et al.** discloses the need for separating the frequencies of the resonators in order to allow for the use of multiple resonators in the same system with little or no confusion as to which resonator is being utilized in the test. Therefore, one of ordinary skill in the art would have known to utilize tuning forks of different resonant frequencies and a low frequency tuning fork in combination with a high frequency tuning fork would ensure the operator of being able to differentiate between the testing signals.

With regards to at least one of the resonators having an operational frequency of less than 1 MHz, **Newell et al.** discloses oscillating the resonators at the resonant frequencies of the resonators. **Tanaka et al.** teaches that the frequency of the tuning forks are dependent upon the size and shape of the tines of the tuning fork resonator and that such dimensions can be designed for a low frequency (see column 9 lines 23-30 where a tuning fork with an approximate frequency of 10 kHz was designed). Therefore, one of ordinary skill in the art would have known to design the resonators for appropriate frequencies, including frequencies less than 1 MHz, which would provide the best test results and yet would not interfere or provide undue errors due to the nature of the type of resonator utilized in the sensing apparatus.

With regards to claim 2, **Newell et al.** discloses the plurality of resonators having different resonance frequencies (see Figure 9B).

With regards to claim 3, **Newell et al.** discloses the plurality of resonators comprising different coatings (see Figure 10) or functionalities (pressure, humidity, temperature, etc.).

With regards to claim 4, **Newell et al.** discloses the plurality of resonators being a membrane oscillator (flexible diaphragm) or thickness shear mode resonator (inherent in the use of an AC-cut sensor). Furthermore, **Tanaka et al.** teaches in figure 26 using more than 10 resonators in a single sensing body. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system with at least one additional mechanical resonator as **Newell et al.** clearly discloses multiple functionalities (pressure, humidity, temperature, etc.) which could be measured by a different resonators.

With regards to claim 7, **Newell et al.** discloses at column 4 lines 27 - 34 that the system uses AT-strip resonators operating in a thickness shear mode with an AC-cut resonator as the temperature sensor (see column 8 line 35). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a thickness shear mode resonator as an additional sensor in the system.

With regards to claim 10, **Newell et al.** discloses the plurality of resonators comprising different functionalities, each of the functionalities designed to bond with a different target molecule (see column 8 line 54 -column 9 line 6).

With regards to claims 11-16, **Newell et al.** discloses the claimed invention with the exception of the plurality of resonators comprising tuning fork resonators with a polymer layer or other selective absorbing layer to detect the presence of specific molecules in a vapor, functionalized tuning fork resonators adapted to detect the presence of specific chemicals in a fluid composition, tuning fork resonators treated with a functionality that changes the resonance frequency of the tuning fork upon exposure to a selected target chemical, tuning fork resonators covered with receptor molecules that bond with specific target molecules, tuning fork resonators functionalized with a material that physically changes when exposed to molecules of a selected chemical such that the mechanical drag on the tuning fork changes upon exposure to the selected chemical, or the plurality of resonators are tuning fork resonators comprising

hydrophobic or hydrophilic functionality. **Tanaka et al.** teaches that it is known in the oscillator art to provide an array of tuning fork resonators in place of the usual crystal oscillators. **Vali et al.** teaches that it is known to utilize tuning forks as chemical sensors in order to determine the presence of specific chemicals in a fluid composition. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the tuning fork oscillators of **Tanaka et al.** for the crystal oscillators of **Newell et al.** as **Vali et al.** teaches the versatility of the tuning fork resonator in being able to determine multiple chemicals with a single sensor and such a substitution would allow for more chemicals to be tested for.

As for the specific use of a polymer layer on the tuning fork as found in Claim 11, **Newell et al.** discloses using different polymers that have various affinities for different gases.

The adaptation of the tuning fork resonators to detect the presence of a specific chemical as found in Claim 12 is taught by **Vali et al.** which discloses at column 2 lines 46-57 testing for marijuana or cocaine.

The tuning fork resonators being treated with a functionality that changes the resonance frequency of the tuning fork upon exposure to a selected target chemical as found in Claim 13 is taught by **Vali et al.** in column 3 at lines 50-62.

The tuning fork resonators being covered with receptor molecules that bond with specific target chemicals as claimed in Claim 14 is taught by **Vali et al.** at column 2 line 58 - column 3 line 4.

The tuning fork resonators being functionalized with a material that physically changes when exposed to molecules of a selected chemical as found in claim 15 would have been obvious to one of ordinary skill in the art as the sensors of **Newell et al.** and **Vali et al.** teach that the use of materials which bond only with specific molecules. One of ordinary skill in the art would have known that certain materials change structure when bonding with specific chemicals. This physical change, whether the addition of mass from the capture of the selected chemical or the changing of the density or viscosity of the material, will change the resonant frequency of the tuning fork by changing the mechanical drag on the tuning fork. Therefore, the system of **Newell et**

al. as modified by **Tanaka et al.** and **Vali et al.** would work equally well with a sensing material which merely catches the specific chemical in order to add mass to the resonator or which changes the density or viscosity of the sensing material in response to the presence of the chemical as both affect the resonant frequency of the resonator performing the test.

As for the tuning fork resonators comprising hydrophobic or hydrophilic functionality as found in claim 16, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of **Newell et al.** as modified with **Tanaka et al.** and **Vali et al.** with such a functionality as water is compound which can be tested and which needs to be tested for in specific environments. Therefore one of ordinary skill in the art would provide the resonators with an appropriate coating for the environment in which it is to be placed.

With regards to claim 17, **Newell et al.** discloses the claimed invention with the exception of the input signal being less than 1 MHz. **Newell et al.** discloses oscillating the resonators at the resonant frequencies of the resonators. **Tanaka et al.** teaches that the frequency of the tuning forks are dependent upon the size and shape of the tines of the tuning fork resonator and that such dimensions can be designed for a low frequency (see column 9 lines 23-30 where a tuning fork with an approximate frequency of 10 kHz was designed). Therefore, one of ordinary skill in the art would have known to design the resonators for appropriate frequencies, including frequencies less than 1 MHz, which would provide the best test results and yet would not interfere or provide undue errors due to the nature of the type of resonator utilized in the sensing apparatus.

With regards to claim 18, **Newell et al.** discloses the claimed invention with the exception of the plurality of resonators being attached together by a common base. **Tanaka et al.** teaches in Figures 12, 14, and 26 utilizing a common base to attach multiple tuning forks together in order to provide ease of handling of the tuning forks. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system with tuning forks on a common base.

With regards to claim 26, it is inherent in the use of a tuning fork that the tines oscillate in opposite phases. This is what allows the tuning fork to operate so efficiently.

Therefore, it is inherent in the system disclosed by **Tanaka et al.** that the tuning forks tines oscillate in opposite phases.

12. Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hollis et al.**

With regards to claim 29, **Hollis et al.** discloses the claimed invention with the exception of the plurality of resonators having different structures, different resonance frequencies, or combinations thereof. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of **Hollis et al.** with resonators having different resonance frequencies as it is known in the art of mechanical resonators that the use of different resonance frequencies allows for the quick differentiation of the multiple sensors utilized in the test system.

With regards to claim 30, **Hollis et al.** discloses utilizing different coatings on the plurality of resonators in order to determine different DNA profiles or bonded sites.

Allowable Subject Matter

13. Claims 5-6, 19, 24-25, and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

14. Applicant's arguments filed 21 January 2005 have been fully considered but they are not persuasive.

With regards to the objection to the drawings, the objection to the drawings for not showing the SAW devices and membrane oscillators has been withdrawn in view of Applicant's amendment to claim 4. The objection to the drawings for not showing the unimorphs and bimorphs has been withdrawn in view of Applicant's pointing out of support in the drawings for such resonators in Figure 4 and as discussed at paragraph [0034] of the specification. However, the objection to the drawings for failure to show the

operation of the resonators in a free decay mode stands. The measurement circuits in Figures 9a and 9b both show a variable frequency input. There is no showing in these Figures of operating the resonators in a free decay mode. Furthermore, an objection has been entered as the drawings fail to show the application of a "spike voltage" to the resonator in order to place the resonator in a resonating mode.

With regards to Applicant's arguments on pages 11-15 of the remarks about the priority to previously filed Applications, these arguments are not persuasive. The Examiner is not questioning the string of Applications which have preceded the present Application. However, Applicant clearly rewrote the specification which was filed in CIP Parent Application 09/133,171 and did not specifically include all of the subject matter of the previously filed Application 08/946,921. The Examiner is not questioning or arguing the statement at the beginning of the specification of 09/133,171 which referenced the parent application. However, as Parent Application 08/946,921 was neither a US Patent nor an allowed US Application, as is required for the incorporation of essential subject matter, at the time of the filing (08/946,921 was not allowed by the office until over 2 years after 09/133,171 was filed), the Examiner can only conclude that Parent Application 08/946,921 was only being relied upon for inadvertently omitted subject matter and nonessential subject matter. Therefore, the inclusion of the subject matter dropped in the re-writing of the specification for filing as CIP Application 09/133,171 in the present application can only be considered a new matter issue and is clearly an attempt by Applicant to recover subject matter which was not considered to be essential subject matter at the time of the filing of CIP Parent 09/133,171.

Furthermore, Parent Application 08/946,921 itself referred to its Parent application 08/898,715, which it incorporated by reference (Application 08/946,921 was a CIP of 08/898,715). If one of ordinary skill in the art was to conclude that Parent Application 08/946,921 itself incorporated essential subject matter by reference (by referring to a parent application, which is the basis of Applicant's arguments), then the incorporation of 08/946,921 into any of the applications for the purposes of documenting essential subject matter not specifically and fully disclosed is improper as essential

subject matter cannot be incorporated from a reference which itself incorporates essential subject matter.

Therefore, the objection to the specification as containing New Matter stands and is hereby made Final.

The rejection of claims 5-6 and 18-19 under 35 U.S.C. §112, first paragraph has been withdrawn in view of Applicant's amendments to these claims.

The rejection of claim 3 under 35 U.S.C. §112, second paragraph has been overcome by Applicant's amendment.

Applicant's arguments with regards to the rejections of claims 1-4 and 7-17 are moot in view of the new grounds of rejection presented above.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rose M. Miller whose telephone number is 571-272-2199. The examiner can normally be reached on Monday - Friday, 7:30 am to 3:30 pm.

Art Unit: 2856


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams can be reached on 571-272-2208. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



RMM

15 April 2005



HEZRON WILLIAMS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800